

ESTTA Tracking number: **ESTTA378412**

Filing date: **11/12/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049926
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Date	11/12/2010
Attachments	Answer_to_Amended_Petition.pdf ( 27 pages )(73453 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>CLOUDSTREET, INC. DBA ROXBURY ENTERTAINMENT,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No. 92049926</p> <p>Registration Nos. 3189543; 3194255; 3291736</p> <p>Mark: ROUTE 66</p> <p>Issued: December 26, 2006; January 2, 2007; September 11, 2007</p>
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**ANSWER TO AMENDED CONSOLIDATED  
PETITION TO CANCEL**

Registrant, Cloudstreet, Inc. d/b/a Roxbury Entertainment ("Registrant"), by its attorneys, for its Answer to Petitioner Penthouse Digital Media Productions, Inc.'s ("Petitioner") Amended Consolidated Petition To Cancel, states as follows:

**I. THE LAWSUIT**

**Amended Consolidated Petition to Cancel No. 1**

On June 12, 2008, Registrant sued Petitioner, Petitioner's parent FriendFinder Networks Inc. (f/k/a Penthouse Media Group Inc.), Petitioner's licensee Pulse Distribution LLC, and Does 1-10 in the United States District Court for the Central District of California, Case No. CV08-03872 (the "Lawsuit"), for an alleged violation of the Lanham Act, federal trademark infringement and other causes of action based on Petitioner's production, release and distribution

in commerce of the adult entertainment motion picture titled PENTHOUSE: ROUTE 66.

Answer to Amended Consolidated Petition to Cancel No. 1

Registrant admits that it sued Petitioner and its affiliated companies on June 12, 2008. Except as admitted, denied. The title to Petitioner's hardcore pornographic film is simply "Route 66."

Amended Consolidated Petition to Cancel No. 2

In the Lawsuit, Registrant claims to be the current successor-in-interest to alleged ROUTE 66 trademark rights arising from the "Route 66" television series originally broadcast via the CBS television network from 1960-1964 starring actors Martin Milner, George Maharis, and later Glenn Corbette.

Answer to Amended Consolidated Petition to Cancel No. 2

Admitted.

Amended Consolidated Petition to Cancel No. 3

In the Lawsuit, Registrant has alleged that Petitioner, among others, unlawfully used "Route 66" as the title of an adult entertainment movie in violation of Registrant's claimed exclusive right to use such term in connection with the goods and services identified in the Registrations.

Answer to Amended Consolidated Petition to Cancel No. 3

Registrant admits that its lawsuit alleges that Petitioner's "Route 66" hardcore pornographic film and its exploitation and marketing infringes Registrant's Marks in Route 66. Except as admitted, denied.

Amended Consolidated Petition to Cancel No. 4

Because Registrant asserted the Registrations against Petitioner, its parent and its licensee in the Lawsuit, Petitioner is, and has been, harmed by the continued subsistence of the Registrations, including the evidentiary presumptions that such Registrations confer upon Registrant. In denying Registrant's motion to dismiss Petitioner's Counterclaims seeking to cancel the in the Lawsuit, the District Court Judge found that because the Registrations were asserted in the Lawsuit, Petitioner has standing and has suffered damage if the Registrations were fraudulently procured, and thus the Petitioner has standing.

Answer to Amended Consolidated Petition to Cancel No. 4

Registrant denies that Petitioner has standing, and affirmatively avers that Petitioner's legal argument is improper pleading. Registrant denies each and every remaining allegation in Paragraph 4.

Amended Consolidated Petition to Cancel No. 5

Although all of Registrant's claims were dismissed in the Lawsuit when the District Court granted Petitioner's motion for summary judgment, Registrant has appealed that decision to the Court of Appeals for the Ninth Circuit. Additionally, Petitioner's Counterclaims in the District Court, which seek damages under Lanham Act § 38 resulting from false registration, Lanham Act § 35(a) as the prevailing party in an exceptional case, and on other grounds, are currently stayed pending the resolution of this Cancellation Proceeding on the validity of the Registrations.

Answer to Amended Consolidated Petition to Cancel No. 5

Registrant denies that Petitioner has standing, and affirmatively avers that Petitioner's legal argument is improper pleading. Registrant denies each and every remaining allegation in Paragraph 5.

## II. THE REGISTRATIONS

### Amended Consolidated Petition to Cancel No. 6

Registrant applied for the use-based On-Going TV Program Registration on July 6, 2005; Registrant filed a Statement of Use for the Motion Picture Film Series Registration on May 22, 2007; and Registrant filed an Amendment to Allege Use for the DVD/Videocassette Registration on July 14, 2006.

### Answer to Amended Consolidated Petition to Cancel No. 6

Admitted.

### Amended Consolidated Petition to Cancel No. 7

The Registrations provide Registrant with certain benefits, including, without limitation: (a) *prima facie* evidence that trademark rights in the ROUTE 66 mark are valid; (b) *prima facie* evidence that the Registrant is the exclusive owner of the ROUTE 66 mark; and (c) the possibility to recover treble damages and attorneys' fees from an adjudicated infringer of the Registrations.

### Answer to Amended Consolidated Petition to Cancel No. 7

Registrant denies that Petitioner has standing, and affirmatively avers that Petitioner's legal argument in this regard is improper pleading. Registrant denies each and every remaining allegation in Paragraph 7.

## III. THE REGISTRATIONS SHOULD BE CANCELLED

### A. The Motion Picture Film Series Registration Should be Cancelled

#### i. The Motion Picture Film Series Registration Should be Cancelled For Fraudulent Procurement Because There Was No Motion Picture "Series"

Amended Consolidated Petition to Cancel No. 8

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 7 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 8

Registrant realleges and incorporates herein by reference its answers to Paragraphs 1 through 7 above, as if stated in full herein.

Amended Consolidated Petition to Cancel No. 9

Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the Motion Picture Film Series Registration because Registrant knew that it had not used the ROUTE 66 mark on a motion picture film series as of the date that Registrant filed its Statement of Use. Specifically, Registrant falsely represented that it "is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance," with knowledge that such statement was false, with the intent of deceiving the Trademark Office into issuing the Motion Picture Film Series Registration to which Registrant was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 9

Registrant denies each and every allegation contained in Paragraph 9.

Amended Consolidated Petition to Cancel No. 10

On May 22, 2007, Registrant submitted a Statement of Use to the Trademark Office in which Registrant represented to the Trademark Office that it was using the ROUTE 66 mark in commerce on or in connection with a "motion picture film series." Registrant made this representation to induce the Trademark Office to issue a registration.

Answer to Amended Consolidated Petition to Cancel No. 10

Registrant admits that it submitted a Statement of Use to the Trademark Office representing that Registrant was using the ROUTE 66 mark in commerce on or in connection with a "motion picture film series." Except as admitted, Registrant denies each and every allegation contained in Paragraph 10.

Amended Consolidated Petition to Cancel No. 11

When Registrant made this representation, Registrant knew that it had not used the ROUTE 66 mark on or in connection with a motion picture film series. Registrant's President was the Fed. R. Civ. P. 30(b)(6) representative on this subject in the Lawsuit, as well as legal counsel, and the signatory for the applications underlying the Registrations (hereinafter, "Hallam"). At his deposition, Hallam admitted that he was not aware, for a fact, that there was a series of films, and has explicitly admitted that Registrant is not in possession of any individual films comprising a series. Furthermore, Registrant has testified that Petitioner's actions, as complained of in the Lawsuit, have allegedly *prevented* Registrant from making a motion picture film. Nevertheless, on May 22, 2007, Hallam signed and submitted, on behalf of Registrant, a Statement of Use falsely representing that Registrant was using the ROUTE 66 mark for motion picture film series.

Answer to Amended Consolidated Petition to Cancel No. 11

Registrant avers that Petitioner's legal arguments and reference to Registrant's false and fraudulent statement of the evidence is improper pleading. Registrant denies each and every allegation in Paragraph 11.

Amended Consolidated Petition to Cancel No. 12

Hallam's background as a lawyer, his knowledge of trademark law, and his direct knowledge of Registrant's claimed rights evidence Registrant's bad faith intent to deceive the

Trademark Office and demonstrate that the false statements surrounding the Registrations were not innocent mistakes. Specifically, Hallam claims in statements filed in the Lawsuit that he is a 1981 graduate of Harvard Law School, a former managing partner at Rosenfeld, Meyer and Susman, a law firm that specialized in intellectual property law, and that Hallam specialized in intellectual property law, including federal trademark and copyright matters, for more than 25 years. Hallam also claims to have been integrally involved in the acquisition of Registrant's rights in ROUTE 66 and the development, production, marketing, advertising, licensing, distribution and sales of Registrant's various entertainment products featuring the ROUTE 66 mark, and Hallam was personally involved in seeking protection for Registrant's ROUTE 66 mark and all of the Registrations. These facts support the conclusion that Hallam had full knowledge of his obligations to state the truth in his declarations supporting the Registrations, knowledge that he was untruthful, and further support that Hallam intended to deceive the Trademark Office into issuing the Motion Picture Film Series Registration when Hallam signed and submitted, on behalf of Registrant, the false Statement of Use. Indeed, Hallam's credibility was called into question in the Lawsuit as the Magistrate Judge in that case sanctioned him and issued an order stating that Hallam was "disingenuous" in his assertions to the District Court.

Answer to Amended Consolidated Petition to Cancel No. 12

Registrant avers that Petitioner's legal argument and defamatory attacks on Registrant's counsel are improper pleading, intended to unfairly prejudice this Board against Registrant and in favor of Petitioner Adult Friend Finder.

Registrant also avers that the Federal Court Magistrate granted two motions to compel in favor of Registrant and against Petitioner, and that such Magistrate further ordered Petitioner's counsel to submit a declaration to the court setting forth under oath her representations as to counsel's full compliance with such discovery order, and that Petitioner's counsel failed and refused to submit the ordered declaration in violation of that Court's order. Registrant admits that its



litigation counsel in the underlying Federal Court litigation graduated from Harvard Law School, and was a partner in the law firm of Rosenfeld, Meyer & Susman. Registrant denies each and every remaining allegation in Paragraph 12.

Amended Consolidated Petition to Cancel No. 13

Because the title of a single creative work may not be registered as a trademark unless the title has been used on a series of creative works, Registrant knowingly made the false statement that it had used the ROUTE 66 mark on a "series" of motion picture films with the intent of deceiving the Trademark Office into issuing the Motion Picture Film Series Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 13

Registrant avers that Petitioner's legal argument is improper pleading. Registrant denies each and every remaining allegation in Paragraph 13.

**ii. The Motion Picture Film Series Registration Should Be Cancelled For Fraudulent Procurement Because Registrant Intentionally Deceived The Trademark Office As The Goods Are Not On "Film"**

Amended Consolidated Petition to Cancel No. 14

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 13 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 14

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraphs 1 through 13.

Amended Consolidated Petition to Cancel No. 15

Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the Motion Picture Film Series Registration because Registrant purposefully failed to amend its application to disclose, in response to a May 15, 2006 Trademark Office Action (the "Office Action"), that the alleged "motion picture film series" is not on "film" but is on some other medium, with the intent of deceiving the Trademark Office into issuing the Motion Picture Film Series Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 15

Registrant denies each and every allegation in Paragraph 15.

Amended Consolidated Petition to Cancel No. 16

On May 18, 2006, the Trademark Office issued an Office Action to Registrant stating, in relevant part:

Applicant has described its Class 9 goods as follows: "Series of motion pictures featuring drama, action and adventure." There is no indication in this description as to the physical nature of the goods, making the description indefinite. The examining attorney suggests the following: "Motion picture film series featuring drama, action, and adventure." ***If the actual goods are not on "film" but some other medium, applicant must amend accordingly.***

A copy of this Office Action is attached hereto as **Exhibit A** (emphasis added).

Answer to Amended Consolidated Petition to Cancel No. 16

Registrant admits that the Trademark Attorney for the PTO issued an Office Action which contained, among other things, the language quoted in Paragraph 16, and that a copy of the Office Action is attached as Exhibit A.

Registrant denies each and every other allegation or implication contained in Paragraph 16.

Amended Consolidated Petition to Cancel No. 17

Despite the Trademark Office's explicit instruction in the Office Action, Registrant failed to amend the description of goods to state that its motion picture was not on "film" but rather on another medium, and Registrant submitted a Statement of Use on May 22, 2007 in which Registrant falsely represented to the Trademark Office that it was using the ROUTE 66 mark in commerce on or in connection with a "motion picture film series."

Answer to Amended Consolidated Petition to Cancel No. 17

Registrant denies each and every allegation contained in Paragraph 17.

Amended Consolidated Petition to Cancel No. 18

When Registrant made this representation, and failed to amend its application in response to the Office Action, Registrant knew that the Trademark Office ordered Registrant to disclose if the motion picture was not on film, and knew that its alleged motion picture was not on "film" but rather that it was on some other medium. Indeed, Registrant has admitted that its alleged motion picture was on DVD, not "on film."

Answer to Amended Consolidated Petition to Cancel No. 18

Registrant denies each and every allegation contained in Paragraph 18.

Amended Consolidated Petition to Cancel No. 19

Registrant knowingly and purposefully failed to amend its application, and made the false material statement that it was using the ROUTE 66 mark in commerce on or in connection with a motion picture film series with the intent of deceiving the Trademark Office

into issuing the Motion Picture Film Series Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 19

Registrant denies each and every allegation contained in Paragraph 19.

**iii. The Motion Picture Film Series Registration Should Be Cancelled For Nonuse**

Amended Consolidated Petition to Cancel No. 20

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 19 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 20

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraphs 1 through 19 above.

Amended Consolidated Petition to Cancel No. 21

As of the filing date of Registrant's Statement of Use for the Motion Picture Film Series Registration, Registrant had not used the ROUTE 66 mark on or in connection with a motion picture film series.

Answer to Amended Consolidated Petition to Cancel No. 21

Registrant denies each and every allegation contained in Paragraph 21.

Amended Consolidated Petition to Cancel No. 22

As of the filing date of the Statement of Use, Registrant had not used the ROUTE 66 mark on or in connection with a "series" of

motion picture films, and the title of a single creative work cannot be registered unless the title has been used on a "series" of creative works.

Answer to Amended Consolidated Petition to Cancel No. 22

Registrant avers that Petitioner's legal argument is improper pleading.

Registrant denies each and every factual allegation of Paragraph 22.

Amended Consolidated Petition to Cancel No. 23

As of the filing date of the Statement of Use, Registrant had not used the ROUTE 66 mark on or in connection with motion picture "film" series, as the medium of the alleged motion picture was not film, but some other medium.

Answer to Amended Consolidated Petition to Cancel No. 23

Registrant denies each and every allegation contained in Paragraph 23.

Amended Consolidated Petition to Cancel No. 24

Any use of Registrant's ROUTE 66 mark prior to filing its Statement of Use was not in fact a *bona fide* use in the ordinary course of commerce, making the Motion Picture Film Series Registration void *ab initio*.

Answer to Amended Consolidated Petition to Cancel No. 24

Registrant avers that Petitioner's legal argument is improper pleading.

Registrant denies each and every other allegation contained in Paragraph 24.

Amended Consolidated Petition to Cancel No. 25

For an application under Section 1(b), a mark must be in use in commerce as of the filing date of a statement of use and as of the registration date to be entitled to registration.

Answer to Amended Consolidated Petition to Cancel No. 25

Registrant avers that Petitioner's assertions of legal arguments or contentions are not proper pleading.

Amended Consolidated Petition to Cancel No. 26

Registrant was not using the ROUTE 66 mark in connection with motion picture film series as of the filing date of the Statement of Use or as of the date the Motion Picture Film Series Registration was registered.

Answer to Amended Consolidated Petition to Cancel No. 26

Registrant denies each and every allegation contained in Paragraph 26.

Amended Consolidated Petition to Cancel No. 27

Registrant was not entitled to obtain a registration for the ROUTE 66 mark because the Statement of Use falsely indicated that the mark was in use in commerce for a motion picture film series when it was not.

Answer to Amended Consolidated Petition to Cancel No. 27

Registrant denies each and every allegation contained in Paragraph 27.

Amended Consolidated Petition to Cancel No. 28

The Motion Picture Film Series Registration should be cancelled for nonuse because the mark ROUTE 66 was not used by Registrant in connection with a motion picture film series as of the filing date of the Statement of Use or as of the registration date.

Answer to Amended Consolidated Petition to Cancel No. 28

Registrant denies each and every allegation contained in Paragraph 28.

**B. The DVD/Videocassette Registration Should Be Cancelled**

**i. The DVD/Videocassette Registration Should Be Cancelled For Fraudulent Procurement**

Amended Consolidated Petition to Cancel No. 29

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 28 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 29

Registrant realleges and incorporates herein its responses to the matters alleged in Paragraphs 1 through 28 above.

Amended Consolidated Petition to Cancel No. 30

Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the DVD/Videocassette Registration because Registrant knew that it had not used the ROUTE 66 mark on DVDs as of the date that Registrant filed its Amendment to Allege Use. Specifically, Registrant falsely represented that it "is using the mark in commerce ... on or in connection with the identified goods and/or services," with the knowledge that such representation was false, with the intent of deceiving the Trademark Office into issuing the DVD/Videocassette Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 30

Registrant denies each and every allegation contained in Paragraph 30. Registrant affirmatively avers that Petitioner and its counsel are seeking to commit fraud on the Board by knowingly and intentionally making the false allegations contained in Paragraph 30 to induce the Board to cancel Registrant's DVD Registration based on such false and fraudulent allegations, allegations which are directly contradicted by the facts known to Petitioner and its counsel and previously alleged by them in their own pleadings, all in violation of their ethical and legal obligations under F.R.C.P 11.

Amended Consolidated Petition to Cancel No. 31

On July 14, 2006, Registrant filed an Amendment to Allege Use, in which Registrant represented to the Trademark Office that it was using the ROUTE 66 mark in commerce on or in connection with "pre-recorded DVD's and videocassettes featuring drama, action and adventure." Registrant made this representation to induce the Trademark Office to issue a registration.

Answer to Amended Consolidated Petition to Cancel No. 31

Registrant admits that it made such a statement in its Amendment to Allege Use, and that such statement was truthful and accurate. Registrant denies every other allegation or implication contained in Paragraph 31.

Amended Consolidated Petition to Cancel No. 32

When Registrant made this representation on July 14, 2006, Registrant knew that it had not used the ROUTE 66 mark on or in connection with DVDs. Indeed, the distributor of Registrant's DVDs, Infinity Entertainment Group, testified at a deposition in the Lawsuit



that its involvement in distributing DVDs for sale in interstate commerce did not begin until 2007. In addition, the president and founder of the marketing company that Registrant employs, Greenleaf + Associates, admitted that its involvement in the sales of Registrant's DVDs did not begin until the summer of 2007. Moreover, Greenleaf + Associates created a press release in October 2007 to promote the DVD release for Registrant. Notably, that press release stated that the "Route 66" television show was "coming to DVD for the first time ever on October 23, [2007]." Furthermore, Amazon.com lists the release date of Registrant's first DVD, "Best of Route 66," as May 1, 2007 – almost a year after Registrant submitted its Amendment of Use.

Answer to Amended Consolidated Petition to Cancel No. 32

Registrant denies that it was not distributing in commerce its DVD's bearing the Mark Route 66 when it made its representation to that effect in July of 2006. Registrant also affirmatively avers that it began selling and distributing in commerce DVD's bearing the Route 66 Mark in 2005, and that Petitioner and its counsel are well aware that Registrant began selling and distributing its Route 66 DVD's in 2005, both directly by Registrant, and through Registrant's first DVD distributors Wizard Industries and Amazon.com. Registrant further affirmatively avers that Petitioner and its counsel received indisputable evidence in the underlying Federal Court litigation in February of 2009 that Registrant was selling its "Best of Route 66" DVD's beginning in September of 2005. Registrant further avers that Petitioner and its counsel have known full well since February of 2009 that Registrant began selling its "Best Of" Route 66 DVD's in 2005, when Registrant produced to Petitioner in the Federal Court litigation numerous purchase orders and invoices reflecting the sales of such DVD's in 2005, documents bearing Bates Stamp Numbers P000520-543, indisputable evidence

that also was explicitly brought to Petitioner's attention in Registrant's Reply in Support of its Motion for Summary Judgment (pp. 15-16) filed with the District Court on November 3, 2009. Petitioner further avers that Registrant and its counsel are knowingly making these false and fraudulent representations to the contrary in an effort to induce the Board into mistakenly canceling Registrant's DVD Mark in Route 66. Registrant also denies each and every contrary allegation contained in Paragraph 32.

Amended Consolidated Petition to Cancel No. 33

Registrant knowingly made the false material statement that it was using the ROUTE 66 mark in commerce on or in connection with "pre-recorded DVDs" as of July 14, 2006 with knowledge that such statement was false, and with the intent of deceiving the Trademark office into issuing the DVD/Videocassette Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 33

Registrant denies each and every allegation contained in Paragraph 33.

**ii. The DVD/Videocassette Registration Should Be Cancelled For Nonuse**

Amended Consolidated Petition to Cancel No. 34

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 33 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 34

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraph 1 through 33 above.

Amended Consolidated Petition to Cancel No. 35

As of the filing date of Registrant's Amendment to Allege Use for the DVD/Videocassette Registration, Registrant had not used the ROUTE 66 mark in commerce on or in connection with pre-recorded DVDs.

Answer to Amended Consolidated Petition to Cancel No. 35

Registrant denies each and every allegation contained in Paragraph 35, and affirmatively avers that Petitioner and its counsel are knowingly and intentionally making false and fraudulent allegations to the contrary, in violation of counsel's ethical and legal obligations under F.R.C.P. 11.

Amended Consolidated Petition to Cancel No. 35

Registrant was not using the ROUTE 66 mark in commerce in connection with pre-recorded DVDs as of the filing date of the Amendment to Allege Use or as of the registration date and, therefore, Registrant was not entitled to obtain the DVD/Videocassette Registration, making the DVD/Videocassette Registration void *ab initio*.

Answer to Amended Consolidated Petition to Cancel No. 36

Registrant denies each and every allegation contained in Paragraph 36, and further affirmatively avers that Petitioner's legal arguments contained in Paragraph 36 are improper pleading.

Amended Consolidated Petition to Cancel No. 37

In the alternative, any use of Registrant's ROUTE 66 mark prior to filing its Amendment to Allege Use was not in fact a *bona fide* use in the ordinary course of commerce, making the DVD/Videocassette Registration void *ab initio*.

Answer to Amended Consolidated Petition to Cancel No. 37

Registrant avers that Petitioner's legal arguments contained in Paragraph 37 are improper pleading, and Registrant further denies each and every allegation contained in Paragraph 37.

Amended Consolidated Petition to Cancel No. 38

The DVD/Videocassette Registration should be cancelled for nonuse because the term ROUTE 66 was not used by Registrant in commerce in connection with DVDs as of the filing date of the Amendment to Allege Use on July 14, 2006 or as of the registration date on December 26, 2006. In the alternative, "DVDs" should be deleted from the DVD/Videocassette Registration for nonuse.

Answer to Amended Consolidated Petition to Cancel No. 38

Registrant denies each and every allegation contained in Paragraph 38, and affirmatively avers that Petitioner's legal arguments are improper pleading.

- iii. The DVD/Videocassette Registration Should Be Cancelled For Abandonment Or, In The Alternative, Partially Cancelled Pursuant To Section 18**

Amended Consolidated Petition to Cancel No. 39

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 38 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 39

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraphs 1 through 38 above.

Amended Consolidated Petition to Cancel No. 40

On information and belief, Registrant has abandoned the DVD/Videocassette Registration because Registrant (including its predecessors-in-interest) ceased using for more than three (3) consecutive years the ROUTE 66 mark in connection with the goods identified in the DVD/Videocassette Registration, constituting *prima facie* evidence of abandonment of the ROUTE 66 mark for such goods.

Answer to Amended Consolidated Petition to Cancel No. 40

Registrant denies each and every allegation contained in Paragraph 40, and affirmatively avers that Petitioner's legal arguments are improper pleading.

Amended Consolidated Petition to Cancel No. 41

In the alternative, Petitioner seeks a partial cancellation of the DVD/Videocassette Registration on the ground that Registrant has abandoned use of the ROUTE 66 mark on or in connection with "videocassettes." On information and belief, Registrant has abandoned use of the ROUTE 66 mark on or in connection with "videocassettes" since Registrant (including its predecessors-in-interest) ceased using for more than three (3) consecutive years the ROUTE 66 mark in connection with videocassettes, constituting *prima facie* evidence of abandonment of the ROUTE 66 mark for videocassettes.

Answer to Amended Consolidated Petition to Cancel No. 41

Registrant avers that Paragraph 41 contains only legal argument and opinions, and are not proper pleading. Registrant further denies each and every legal argument and allegation contained in Paragraph 41.

**C. The On-Going TV Program Registration Should Be Cancelled**

**i. The On-Going TV Program Registration Should Be Cancelled For Fraudulent Procurement**

Amended Consolidated Petition to Cancel No. 42

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 41 of this Amended Consolidated Petition to Cancel.

Answer to Amended Consolidated Petition to Cancel No. 42

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraphs 1 through 41 above.

Amended Consolidated Petition to Cancel No. 43

Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the On-Going TV Program Registration because Registrant knew that it was not rendering the claimed services when it filed the use-based application. Specifically, Registrant falsely represented that it "is using the mark in commerce ... on or in connection with the identified goods and/or services," with the knowledge that such representation was false, with the intent of deceiving the Trademark Office into issuing the On-Going TV Program Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 43

Registrant denies each and every allegation contained in Paragraph 43.

Registrant also affirmatively avers that Petitioner's legal arguments and conclusions are not proper pleading.

Amended Consolidated Petition to Cancel No. 44

On July 6, 2005, Registrant filed a use-based application in which Registrant represented to the Trademark Office that it was using the ROUTE 66 mark in commerce on or in connection with a television series and television production services. Registrant made this representation to induce the Trademark Office to issue a registration.

Answer to Amended Consolidated Petition to Cancel No. 44

Petitioner denies each and every allegation contained in Paragraph 44.

Amended Consolidated Petition to Cancel No. 45

When Registrant made this representation, Registrant knew that its predecessors-in-interest had abandoned use of the ROUTE 66 mark for a television program as of the time Registrant filed the underlying application on July 6, 2005, and that Registrant was not rendering the claimed services. Indeed, public records show that Registrant's "ROUTE 66" television series was not televised in commerce between its initial run cancellation in 1964 and 1985, between 1987 and 1993, and as of the date Registrant filed the underlying use-based application. Despite discovery requests in the Lawsuit, no evidence was produced by Registrant which contradicts these facts. Furthermore, Registrant itself took the position that its predecessor-in-interest to the ROUTE 66 mark had abandoned the mark since Registrant testified that it obtained its rights to the television series based on a reversion of rights that occurred when its predecessor-in-interest failed to continuously use the mark in commerce for an extended period of time in the late 1990s or early 2000s.

Answer to Amended Consolidated Petition to Cancel No. 45

Registrant denies each and every allegation contained in Paragraph 45.

Amended Consolidated Petition to Cancel No. 46

Additionally, when Registrant made these false representations to the Trademark Office, it also knew that it was not rendering any "television production services" in connection with the ROUTE 66 mark as of the time Registrant filed the underlying use-based application.

Answer to Amended Consolidated Petition to Cancel No. 46

Registrant denies each and every allegation contained in Paragraph 46.

Amended Consolidated Petition to Cancel No. 47

Registrant knowingly made the false material statements that it was using the ROUTE 66 mark for a television series or for television production services with the intent of deceiving the Trademark Office into issuing the On-Going TV Program Registration to which it was not entitled.

Answer to Amended Consolidated Petition to Cancel No. 47

Registrant denies each and every allegation contained in Paragraph 47.

**ii. The On-Going TV Program Registration Should Be Cancelled For Abandonment**

Amended Consolidated Petition to Cancel No. 48

Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 47 of this Amended Consolidated Petition to Cancel.



Answer to Amended Consolidated Petition to Cancel No. 48

Registrant realleges and incorporates herein by reference its answers to the matters alleged in Paragraphs 1 through 47 above.

Amended Consolidated Petition to Cancel No. 49

On information and belief, Registrant has abandoned the On-Going TV Program Registration because Registrant (including its predecessors-in-interest) ceased using for more than three (3) consecutive years the ROUTE 66 mark in connection with the services identified in the On-Going TV Program Registration, constituting *prima facie* evidence of abandonment of the ROUTE 66 mark for such services.

Answer to Amended Consolidated Petition to Cancel No. 49

Registrant denies each and every allegation contained herein, and affirmatively avers that Petitioner's legal arguments and conclusions are improper pleading.

Amended Consolidated Petition to Cancel No. 50

Once a mark has become abandoned, a party cannot cure that abandonment by subsequently making use. A subsequent readoption of a mark is in the nature of a new first use of that mark.

Answer to Amended Consolidated Petition to Cancel No. 50

Petitioner denies each and every legal argument and opinion contained in Paragraph 50, and avers that such legal argument and opinion are not proper pleading.

## ***AFFIRMATIVE DEFENSES***

### **First Affirmative Defense**

Petitioner's Amended Petition to Cancel fails to state a claim upon which relief can be granted.

### **Second Affirmative Defense**

Petitioner lacks standing under the applicable provisions of the Lanham Act as it lacks a real interest in the outcome of this proceeding and a reasonable belief of damage, and lacks the requisite cognizable damage or actual injury to state a claim for relief under the applicable provisions of federal law.

### **Third Affirmative Defense**

Petitioner's cancellation claims based on alleged fraud fail to set forth with sufficient particularity allegations of fraud and mistake and special damages as required by FRCP 9(b) and the *Bose* decision.

### **Fourth Affirmative Defense**

Petitioner's cancellation claims are barred under the equitable doctrine of unclean hands due to Petitioner's use of Registrant's Route 66 Mark to sell to internet consumers, Petitioner's sexually explicit websites "Adult Friend Finder" and "Adult Friend Wanted," offering sexual services to such internet consumers for payment to Petitioner of an access or subscription fee.

### **Fifth Affirmative Defense**

Each of Petitioner's cancellation claims based on "abandonment" fails to allege the requisite factual elements to set forth such claims of abandonment,

including but not limited to specific allegations of Registrant's intent to abandon its Marks.

Sixth Affirmative Defense

Petitioner's claim to cancel Registrant's DVD Registration is barred by the doctrine of estoppel as a result of Petitioner's and its counsel's knowingly false assertions and contradictory allegations regarding Registrant's date of first use in connection with the sale of DVDs.

Seventh Affirmative Defense

Each of Petitioner's cancellation claims is barred under the doctrine of laches.

Eighth Affirmative Defense

Petitioner's claims are barred as an unlawful attempt to abridge Registrant's First Amendment right of Free Speech.

Ninth Affirmative Defense

Petitioner's claims are barred because they are an unlawful attempt by Petitioner to take for Petitioner's own unlawful use Registrant's rights in and to its Route 66 Mark and entertainment products sold in connection therewith.

Respectfully submitted,

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/s/  
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Dated: November 12, 2010

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing **ANSWER TO AMENDED CONSOLIDATED PETITION TO CANCEL** was served by first class mail, postage prepaid, on this 12<sup>TH</sup> day of November 2010, upon counsel for Petitioner:

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/s/  
PAUL D. SUPNIK